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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,202	02/01/2001	Johnny B. Corvin	UV-181	7104

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EXAMINER	
BELIVEAU, SCOTT E	
ART UNIT	**PAPER NUMBER**
2614	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/775,202	Applicant(s) CORVIN ET AL.	
	Examiner Scott Beliveau	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-59* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-59* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 February 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4, 5*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 2, 8, 11, 14-18, 20, 27, 30-34, 36, 41, 44, 46-48, 50, 55, and 57-59 of this application as follows:The provisional application fails to suggest that the "promotion is selected based upon the content of the program" as recited in claims 2, 20, 36, and 50;

- The provisional application fails to provide adequate support for "recording a flag with the promotion to indicate the beginning of the program during playback" as recited in claims 8 and 41;
- The provisional application fails to suggest that the "promotion is recorded at any desired point within the program" recited in claims 11, 27, 44, and 55;
- The provisional application fails to provide support for the particular method of distribution of the program, the promotion, and the program guide over either a "single broadcast channel" or a "plurality of broadcast channels" as recited in claims 14, 15, 30, 31, 46, 47, 57, and 58;
- The provisional application does not disclose details regarding the storage of the program, the promotion, and the program guide data with a "storage unit" or a "plurality of storage units", as recited in claims 16, 17, 33, 32, 48, and 59.

Information Disclosure Statement

2. The information disclosure statement filed 12 December 2001 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the "JP 3063990 A" reference referred to therein has not been considered.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 210 (Figure 2) and 1110 (Figure 11). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 6, 19, 20, 24-27, 35, 36, 49, 50, and 52-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Dimitri et al. (US Pat No. 6,574,424).

In consideration of claims 1, 19, 35 and 49, the Dimitri et al. reference discloses a "system" and "method for providing promotions with recorded programs" wherein both a "program" or movie and a "promotion" are "selected . . . to record" on a DVD via a "processor". Subsequently, both forms of content are "caused . . . to be recorded" and are "caused" to be "presented during a playback of the program" as directed by a "user input device that receives user input" or DVD player (Abstract; Col 1, Lines 16-62; Col 3, Line 1 – Col 6, Line 44).

Claims 2, 20, 36, and 50 are rejected wherein the "promotion is selected based upon the content of the program" (Col 6, Lines 7-17).

Claim 6 is rejected wherein "both the program and the promotion" are "recorded" on a "storage unit" such as a DVD (Col 7, Lines 17-23).

Claims 24-27 and 52-54 are rejected wherein the "promotion" may be "integrated" at the "beginning of the program", the "end of the program", the "beginning and the end of the program", or "at any desired point within the program" (Abstract).

6. Claims 1, 3-6, 12-19, 21-23, 28-35, 37-39, 45-49, 51, and 56-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Arai et al. (US Pat No. 6,486,920).

In consideration of claims 1, 19, 35 and 49, the Arai et al. reference discloses a "system" and "method for providing promotions with recorded programs" wherein both a "program" or movie and a "promotion" are "selected . . . to record" via a "processor" [100] (Figure 44). Subsequently, both forms of content are "caused . . . to be recorded" and are "caused" to be "presented during a playback of the program" as directed by a "user input device that receives user input" [9] (Col 10, Lines 39-42; Col 16, Line 11 – Col 17, Line 27).

Claims 3-5, 21-23, 37-39, and 51 are rejected wherein the "selecting of the program is based on user input" of a "specific program" or "program designation" (ex. title) (Figure 34).

Claim 6 is rejected wherein the method further comprises "recording both the program and the promotion on a storage unit" [20] (Figure 44).

Claims 12, 13, 16-18, 28, 29, 32-34, 45, 48, 56, and 59 are rejected wherein the method further comprises "receiving the program and the promotion" and "program guide data" and subsequently "storing" them on a "storage unit" comprising a "plurality of storage units" [2/20]

Claims 14, 15, 30, 31, 46, 47, 57, and 58 are rejected wherein the "program, the promotion, and the program guide data are received" either via a "single broadcast channel" or via a "plurality of broadcast channels" (Col 15, Lines 30-46).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (US Pat No. 5,353,121) (of record) in view of Zigmond et al. (US Pat No. 6,698,020).

In consideration of claims 1, 19, 35 and 49, the Young et al. reference discloses a "system" and "method" for "selecting" and "causing" a program to be recorded under to instructions of a "processor" [228] and a "user input device that receives user input" [212] (Col 19, Lines 13). The reference, however, does not explicitly disclose nor preclude the further "selection", "recording", and "playback" of a "promotion" in conjunction with the recorded program.

The Zigmond et al. reference discloses a "system" and "method for providing promotions with recorded programs" comprising "selecting a promotion to record"

and "causing the program and the promotion to be recorded" and subsequently "causing the promotion to be presented during a playback of the program" (Col 14, Lines 1-12). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to combine the Young et al. program selection and recording teachings in conjunction with the promotion insertion and recording teachings of Zigmond et al. for the purpose of providing a means to specifically target, deliver, and present individually targeted advertisements to viewers regardless of the source of the media in order to effectively reach the consumer (Zigmond et al.: Col 3, Line 45 – Col 4, Line 3).

Claims 2, 20, 36, and 50 are rejected wherein the "promotion is selected based upon the content of the program" (Zigmond et al.: Col 12, Line 60 – Col 13, Line 6).

Claims 3-5, 21-23, 37-39, and 51 are rejected wherein the "selecting of the program is based on user input" of a "specific program" or "program designation" (ex. title) (Young et al.: Col 10, Lines 29-41).

Claim 6 is rejected wherein the method further comprises "recording both the program and the promotion on a storage unit" [207] or VCR.

In consideration of claims 7, 9-11, 24-27, and 52-54, the Zigmond et al. reference discloses that "promotions" may be displayed either so as to replace existing advertisement slots or may be placed at any point in the programming. Accordingly, during the recording of such a program a promotion would be "recorded" at the "beginning of the program", the "end of the program", the "beginning and the end of the program", or "at any desired point within the program" (Zigmond et al.: Col 14,

Lines 1-12; Col 16, Lines 20-43). Similiarly, the playback of the aforementioned recorded media may have commercials "integrated" at different points in time.

Claims 8 and 41 are rejected wherein the Young et al. reference is operable to "record a flag . . to indicate the beginning of the program during playback" so as to locate the beginning of a particular program (Col 19, Lines 46-61).

Claims 12, 13, 16-18, 28, 29, 32-34, 45, 48, 56, and 59 are rejected wherein the method further comprises "receiving the program and the promotion" and "program guide data" and subsequently "storing" them on a "storage unit" comprising a "plurality of storage units" (Zigmond et al.: Figure 5; Col 12, Line 60 – Col 13, Line 6; Col 14, Lines 1-12; Col 15, Lines 24-34).

Claims 14, 15, 30, 31, 46, 47, 57, and 58 are rejected wherein the "program, the promotion, and the program guide data are received" either via a "single broadcast channel" or via a "plurality of broadcast channels" (Zigmond et al. Col 7, Lines 1-25; Col 14, Line 66 – Col 15, Line 16)(Young et al.: Col 18, Lines 37-55).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Barton (US Pub No. 2001/0049820) reference discloses a method for displaying an advertisement both before and after a program that has been recorded on a DVR.

- The Eldering (US Pub No. 2002/0083439) reference discloses a system and method for inserting advertisements into recorded data from a VCR or PVR.
- The Shintani et al. (US Pub No. 2002/0124249) reference discloses an advertising insertion technique for use during playback of stored entertainment content.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB
August 10, 2004

JOHN MILLER
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